

**REMARKS**

Claim 1 has been canceled, and claim 2 has been placed in independent form. Claim 2 has also been amended based on the disclosure at, e.g., page 7, lines 10-12. Also, claims 2 and 3 have been amended so that they do not include  $\alpha$ -tocopherol derivatives (i.e., so that they do not include derivatives in which R<sub>3</sub>, R<sub>4</sub>, and R<sub>5</sub> represent methyl at the same time). In view of this amendment, claims 4-6 have been canceled. Claims 3, 7, 9, 11, 12 and 14 have been amended so that they depend on claim 2 instead of canceled claim 1.

Entry of the above amendment is respectfully requested.

**Certified Copy of Priority Document**

On the Office Action Summary, the Examiner has acknowledged Applicants' claim for priority but has not indicated that a copy of the certified copy of the priority document has been received from the International Bureau.

Since the Notice of Acceptance indicates that the priority document was received, and since a copy of the certified copy of the priority document is in the PAIR system on the USPTO website, Applicants respectfully request that the Examiner indicate in the next communication from the USPTO that a copy of the certified copy of the priority document has been received from the International Bureau.

**PTO/SB/08 Form filed September 4, 2004**

Attached to the Office Action are initialed copies of the PTO/SB/08 forms filed on September 2, 2004 and March 29, 2006, in which the Examiner has initialed all the citations

except for the WO 98/51679 A1 citation, which has been lined out on the September 2, 2004 PTO/SB/08 form. On review, it is not clear why the Examiner did not consider WO 98/51679 A1, since a copy of the reference was provided (and can be seen in the PAIR system) and since a concise explanation of the relevance of that reference was included in the Information Disclosure Statement (IDS) filed September 2, 2004 as follows:

In compliance with the concise explanation requirement under 37 C.F.R. § 1.98(a)(3) for foreign language documents, Applicant encloses herewith a copy of a Communication from a foreign patent office in a counterpart application citing such a document, together with an English-language version (if not already included) of at least that portion of the Communication indicating the degree of relevance found by the foreign patent office. Also, the foreign language document, WO 98/51679, includes an English-language Abstract.

In this regard, Applicants note that MPEP 609.04(a) III. states in the paragraph bridging pages 600-153 to 600-154 that:

Submission of an English language abstract of a reference may fulfill the requirement for a concise explanation. Where the information listed is not in the English language, but was cited in a search report or other action by a foreign patent office in a counterpart foreign application, the requirement for a concise explanation of relevance can be satisfied by submitting an English-language version of the search report or action which indicates the degree of relevance found by the foreign office. This may be an explanation of which portion of the reference is particularly relevant, to which claims it applies, or merely an "X", "Y", or "A" indication on a search report.

Accordingly, Applicants respectfully request that WO 98/51679 A1 be considered and made of record in the next communication from the PTO, either in a PTO-892 form or in a newly-initialed copy of the September 2, 2004 PTO/SB/08 form.

### **Anticipation Rejection**

On page 2 of the Office Action, claims 1-6 and 11-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Takata et al., J. Pharm. Sci. (1995), Vol. 84, No. 1, pages 96-100.

In response, Applicants submit that the claims have been amended so that any compounds overlapping with Takata et al have been completely deleted from the claim scope, namely, by limiting the R<sub>3</sub>, R<sub>4</sub>, and R<sub>5</sub> so that they are not a methyl group at the same time. In this regard, Applicants note that the corresponding functional groups in Takata et al are all methyl group at the same time, such that Takata et al does not teach or suggest the invention as recited in the amended claims

Thus, Applicants submit that the invention as recited in the amended claims is patentable over Takata et al, and withdrawal of this rejection is respectfully requested.

### **Obviousness Rejection**

On page 3 of the Office Action, claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gordon et al. (USPN 5,932,612).

In response, Applicants submit that the present invention is not obvious over Gordon et al for the following reasons.

(1) Gordon et al discloses hydroquinone, not tocopherols or derivative thereof, for treating hyperpigmentation;

(2) Gordon et al discloses that hydroquinone has side effects such as burning, redness, sensitization, and irritation (see col. 1, lines 28-37);

(3) Gordon et al discloses that tocopherol can be mixed with hydroquinone to reduce such side effects (see col. 1, lines 44-49);

(4) Therefore, Gordon et al fails to teach a composition containing tocopherol as a main ingredient for treating hyperpigmentation;

(5) In the amendments to the claims, the main ingredient in the composition is tocopherol alkylglycine ester, not tocopherol acetate, free tocopherol, or tocopherol linoleate as disclosed in Gordon et al (see Table 1 and col. 1, line 62).

In view of the above, Applicants submit that one of ordinary skill in the art would not have been motivated to arrive at the present invention from the cited art, and that there is a striking difference in the structure of the compound of the present invention and the compound in the cited art.

Thus, Applicants submit that the present invention is not obvious, and withdrawal of this rejection is respectfully requested.

## **Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

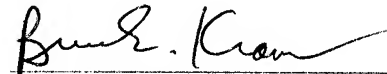
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**23373**

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